

Applicants: Elena Feinstein, et al.
Serial No.: 10/575,121
Filed: October 6, 2004
Page 5

Remarks

Claims 26-45 were pending in the subject application. By this Amendment, applicants have amended claim 35.

Claim 35 has been amended to eliminate references to sequences in tables, according to the Examiner's requirement on page 8 of the March 9, 2009 Office Action.

Accordingly, applicants maintain that these amendments raise no issue of new matter and respectfully request that the Examiner enter this Amendment. Upon entry of this Amendment claims 26-45 will be pending and under examination.

Response to Restriction Requirements

Restriction Requirement:

In the March 9, 2009 Office Action, the Examiner required restriction under 35 U.S.C. §121 of pending claims 26-45 to one of four allegedly patentably distinct inventions.

- I. Claims 26-29 and 37-39, drawn to a double stranded oligonucleotide wherein one strand comprises any of SEQ ID Nos. 3-45 and 67.
- II. Claims 30, 31, 33, 34, 36, 40, 41 and 43-45, drawn to a method treating a neurodegenerative disease in a subject comprising a BMP2A inhibitor wherein the inhibitor is a siRNA, wherein the siRNA has a sequence set forth in any of SEQ ID Nos. 25-45, 67, 1-2, 4-6, 14-16 or 18-22.
- III. Claims 30, 31, 33, 35, 36, 41, 43, 44, and 45, drawn to a method treating a neurodegenerative disease in a subject comprising a BMP2A inhibitor wherein the inhibitor is a siRNA, wherein the siRNA has a sequence set forth in any of SEQ ID Nos. 1 or 2.
- IV. Claims 30-32, 36 and 42, drawn to a method treating a neurodegenerative disease comprising a BMP2A inhibitor wherein the inhibitor is an antisense compound.

In response to the restriction requirement, applicants hereby elect, with traverse, to prosecute the invention identified by the Examiner as Group I, claims 26-29 and 37-39.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Nevertheless, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application

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Serial No.: 10/575,121
Filed: October 6, 2004
Page 7

would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to any of Groups I-IV would identify art for any of the other Groups. Since there is no serious burden on the Examiner to examine Groups I-IV in the subject application, the Examiner should examine Groups I-IV together.

Election of Species

On page 6 of the Office Action the Examiner required that applicants elect one SEQ ID No. should Group I, II or III be elected. On page 6, the Examiner asserts that "oligonucleotides having SEQ ID Nos. as claimed are distinct inventions". The Examiner further asserts that "[t]he search and examination of all agents is burdensome because the searches are not coextensive."

In response applicants elect, with traverse, the siRNA of ID No. 1 in Table A (Sense: SEQ ID No. 3; Antisense: SEQ ID No. 25.).

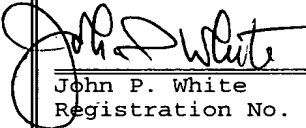
Applicants: Elena Feinstein, et al.
Serial No.: 10/575,121
Filed: October 6, 2004
Page 8

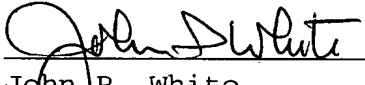
If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

 May 11, 2009
John P. White Date
Registration No. 28,678


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